

Applicant : William Harold Jay
Serial No. : 09/509,301
Filed : March 23, 2000
Page : 2

Attorney's Docket No.: 11750-
002001 / 2274032/PO9462/97-MJC

REMARKS

Applicant has amended claim 7 to promote clarity. No new matter has been introduced. Claims 1-12 are currently pending. Reconsideration of the application, as amended, is requested in view of the remarks below.

Rejection under 35 U.S.C. § 112, second paragraph

Claim 7 is rejected under 35 U.S.C. § 112, second paragraph, as being indefinite. See the Office Action, page 2, lines 6-8. Applicant submits that this rejection has been overcome by the above amendment.

Rejection under 35 U.S.C. § 102(b)

Claims 1 and 3 are rejected under 35 U.S.C. § 102(b) as being anticipated by Hsueh (U.S. Patent 5,536,264). Applicant respectfully traverses as follows.

Claim 1 is an independent claim from which claim 3 depends. The subject matter of claim 1 is based on Applicant's discovery that by embedding an ion exchange material in a superabsorbent polyurethane foam one is able to achieve superior ion exchange performance. See page 2, lines 17-18. More specifically, claim 1 covers an ion exchange material that includes two components: (1) a superabsorbent polyurethane foam, and (2) an ion exchange medium in the superabsorbent polyurethane foam. In other words, in this ion exchange material, the ion exchange properties are introduced by incorporating into a superabsorbent polyurethane foam an ion exchange medium. Thus, commercially available ion exchange resins, preferably after being micronized, can be conveniently incorporated into a superabsorbent polyurethane foam.

To support his rejection, the Examiner points to two passages in Hsueh: "Hsueh describes a superabsorbent polymer col 1 line 32 having ion exchange properties and suggested for use in ion exchange columns col 51 line 32." See the Office Action, page 2, lines 2-3.

Applicant would like to point out that, contrary to the Examiner's assertion, the first Hsueh passage (column 1, line 32) does not mention ion exchange properties. In any event, it only refers generically to a superabsorbent, not specifically to a superabsorbent polyurethane

Applicant : William Harold Say
Serial No. : 09/509,301
Filed : March 23, 2000
Page : 3

Attorney's Docket No.: 11750-
002001 / 2274032/PO9462/97-MJC

foam recited in claim 1. The second Hsueh passage (column 51, line 32) states generically that an absorbent composite can be used in an ion exchange ion column without providing any structural features of such a composite. Again, neither does this passage specifically mention a superabsorbent polyurethane foam, let alone one "having an ion exchange medium contained therein" as required by claim 1. It is well established that a species or subgenus is not anticipated by a genus. See the Manual of Patent Examining Procedure, Section 2144.08 and the illustrative cases cited therein. Thus, the two passages relied on by the Examiner clearly do not anticipate claim 1. Neither do they anticipate claim 3, which depends from claim 1.

Apparently referring to the word "bead" recited in claim 3, the Examiner further asserts that "[i]t is widely known that ion exchange column media are typically in the form of beads, as shown by USP 5900146 to Ballard." See the Office Action, page 2, lines 3-5. However, as discussed above, claim 3, like claim 1, bases its patentability on incorporating an ion exchange medium into a superabsorbent polyurethane foam, not on the form of the ion exchange medium. Thus, the Examiner's reliance on Ballard is misplaced.

For the reasons set forth above, it is respectfully requested this rejection of claims 1 and 3 be withdrawn.

Allowable subject matter

The Examiner concludes that "claims 2 and 4-12 are allowable over the prior art of record." See the Office Action, page 2, lines 9-15. Apparently, it is the Examiner's position that claims 2 and 4-12 cover allowable subject matter, but still cannot be allowed as all of them depend, directly or indirectly, from rejected claim 1 or 3, and claim 7 is indefinite. In view of the above amendment and remarks, Applicant submits that all of these claims are now in condition for allowance.

CONCLUSION

For the remarks above, Applicant asks that claims 1-12, as amended, be allowed. Attached is a marked-up version of the changes being made by the current amendment.

Applicant : William Harold Tsay
Serial No. : 09/509,301
Filed : March 23, 2000
Page : 4

Attorney's Docket No.: 11750-
002001 / 2274032/PO9462/97-MJC

Pursuant to 37 CFR § 1.136, Applicant hereby petitions that the period for response to the Office Action dated June 28, 2002, be extended for three months to and including December 30, 2002 (December 28 being a Saturday and December 29 being a Sunday). Enclosed is a check for \$460 for the required fee.

Please apply any other charges to Deposit Account No. 06-1050, referencing Attorney's Docket No. 11750-002001.

Respectfully submitted,

Date: 12 - 30 - 02

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